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In re Application of	:	DECISION ON
GORDON	:	
Application No.: 10/593,469	:	PETITION UNDER
PCT No.: PCT/GB2005/000788	:	
Int. Filing Date: 02 March 2005	:	37 CFR § 1.47(b)
Priority Date: 19 March 2004	:	
Attorney Docket No.: Q96948	:	
For: REPROGRAMMING A NON-	:	
VOLATILE SOLID STATE MEMORY	:	
SYSTEM	:	

This is a decision on applicant's petition under 37 CFR 1.47(b) filed in the United States Patent and Trademark Office (USPTO) on 29 September 2008. The petition is **DISMISSED** without prejudice.

BACKGROUND

On 02 March 2005, applicant filed international application PCT/GB2005/000788, which designated the US and claimed a priority date of 19 March 2004. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 29 September 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 19 September 2006.

On 19 September 2006, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 10 March 2008, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 29 September 2008, applicant submitted the instant petition under 37 CFR 1.47(b). The petition was accompanied by, *inter alia*, a petition/fee for a five-month extension of time, a statement of facts by Stephen Haley, an Invention Disclosure Agreement, a copy of a letter from non-signing inventor David Gordon to Stephen Haley dated 01 May 2008, and a copy of a letter from David Gordon to Stephen Haley dated 11 July 2008.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Items (1), (3), (4), and (6) have been met. (As to item (1), the petition fee is \$200 rather than \$130. The balance has been charged to Deposit Account 19-4880.)

Item (2) has also been met. It has been established that a copy of the application papers were provided to Mr. Gordon and that Mr. Gordon refuses to sign.

Item (5) has not been met. It is urged that the Invention Disclosure Agreement signed by Mr. Gordon establishes sufficient proprietary interest. However, it is not clear that this document refers to the invention of the instant application. The statement of Stephen Haley also refers to United Kingdom patent law regarding the ownership of the present invention. Attention is directed to MPEP § 409.03 which states that a proprietary interest may be demonstrated

by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Additionally, a chain of title from Panasonic Mobile Communications Development Laboratory to Matsushita Electric Europe, Ltd. to Matsushita Electric Industrial Co., Ltd. needs to be established, e.g., by a letter of incorporation.

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

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